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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,285	06/24/2003	Michael E. Shanahan	MES/002CONII	4408
36550 7590 03/26/2008 KALIKO & YEAGER, L.L.C. 500 NORTH FRANKLIN TURNPIKE RAMSEY, NJ 07446				
EXAMINER NGUYEN, TUAN HOANG				
ART UNIT 2618		PAPER NUMBER		
MAIL DATE 03/26/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/603,285

Applicant(s)

SHANAHAN, MICHAEL E.

Examiner

TUAN H. NGUYEN

Art Unit

2618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-12, 14-15, 18-19, 21-39, 41-42, 45-46 and 48-56 is/are pending in the application.
- 4a) Of the above claim(s) 1-2, 13, 16-17, 20, 40, 43-44 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-12, 14, 15, 18, 19, 21-39, 41, 42, 45, 46 and 48-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 11/13/2007 with respect to claims 3-12, 14-15, 18, 19, 21-39, 41-42, 45, 46, and 48-56 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 11/13/2007 has been considered by Examiner and made of record in the application file.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 3-12, 14-15, 18, 19, 21-39, 41-42, 45, 46 and 48-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims limitations of US Pat. No. 6,496,692; 7,149,509; 7,295,864; 7,257,395; 7,289,798 and US Pub. No. 2007/0099604 and 2007/0099606. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations, i.e., a method for providing a video file selected by a caller to a wireless telephone of a called party the video file being used by the wireless telephone of the called party as an indicia of an incoming communications, the method comprising: allowing the caller to browse a plurality of video files; allowing the caller user select the video file from the plurality of video files; sending the selected video file to the wireless telephone of the called party; and playing the selected video file on the wireless telephone of the called party as an indicia of an incoming communication, are transparently found US Pat. No. 6,496,692; 7,149,509; 7,295,864; 7,257,395; 7,289,798 and US Pub. No. 2007/0099604 and 2007/0099606.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 3-5, 8-11, 12-14, 17-20, 21, 23-24, 26-29, 30-32, 35-38, 39-41, 44-47, 48, 50-51, and 53-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Galensky et al. (US PAT. 6,845,398 hereinafter, "Galensky").

Consider claim 3, 12, 21, 30, 39, and 48, Galensky teaches a method for providing a video file selected by a caller to a wireless telephone of a called party the video file being used by the wireless telephone of the called party as an indicia of an incoming communications, the method comprising: allowing the caller to browse a plurality of video files (fig. 1 col. 3 lines 19-37); allowing the caller user select the video file from the plurality of video files (col. 3 lines 52-61); sending the selected video file to the wireless telephone of the called party (col. 6 lines 28-44); and playing the selected video file on the wireless telephone of the called party as an indicia of an incoming communication (col. 7 lines 11-23).

Consider claims 4, 13, 23, 31, 40, and 50, Galensky further teaches allowing the caller to search a database of video files for a certain video file using title or description information (col. 4 lines 54-65).

Consider claims 5, 14, 24, 32, 41, and 51, Galensky further teaches allowing the caller to review the selected video file before sending the selected video file to the wireless telephone of the called party (col. 6 lines 28-44).

Consider claims 8, 17, 26, 35, 44, and 53, Galensky further teaches the selected video file is transmitted to the telephone of the called party prior to initiating the incoming communication (col. 4 line 66 through col. 5 line 9).

Consider claims 9, 18, 27, 36, 45, and 54, Galensky further teaches the selected video file is in a format selected from the group comprising MPEG, JPEG, AVI, or DVD format (col. 1 lines 19-27).

Consider claims 10, 19, 28, 37, 46, and 55, Galensky further teaches providing copyright protection for the selected video file to help prevent unauthorized distribution of the selected video file (col. 6 lines 45-58).

Consider claims 11, 20, 29, 38, 47, and 56, Galensky further teaches determining a format of the selected video file determining a format required by the telephone of the called party (col. 5 lines 18-30); comparing the format of the selected video file with the format required by the telephone of the called party (col. 5 lines 18-30); and optionally converting the format of the selected video file to the format required by the telephone of the called party (col. 5 lines 18-30).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-7, 15-16, 22, 25, 33-34, 42-43, 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galensky in view of Isomursu et al. (US PAT. 7,088,990 hereinafter, "Isomursu").

Consider claims 6, 15, 25, 33, 42, and 52, Galensky teaches a method for providing a video file selected by a caller to a wireless telephone of a called party the video file being used by the wireless telephone of the called party as an indicia of an incoming communications, the method comprising: allowing the caller to browse a plurality of video files; allowing the caller user select the video file from the plurality of video files; sending the selected video file to the wireless telephone of the called party; and playing the selected video file on the wireless telephone of the called party as an indicia of an incoming communication.

Galensky does not explicitly show that providing the caller with the option of modifying the selected video file before sending the selected video file to the wireless telephone of the called party.

In the same field of endeavor, Isomursu teaches providing the caller with the option of modifying the selected video file before sending the selected video file to the wireless telephone of the called party (col. 14 line 47 through col. 15 line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, providing the caller with the option of modifying the selected video file before sending the selected video file to the wireless telephone of the called party, as taught by Isomursu, in order to provide the terminal capable of supporting a plurality of applications and having communicating user messages wherein it comprises receiving user messages having data and a header relating to one of applications and addressing the data to a respective application according to header.

Consider claims 7, 16, 34, and 43, Isomursu further teaches the selected video file resides, at least in part, on a network computer, and wherein the selected video file is sent to the telephone of the called party substantially concurrently with the incoming communication (col. 10 lines 32-57).

Consider claims 22 and 49, Isomursu further teaches configured to operate in conjunction with the distribution computer to confirm the selected video file/polyphonic audio file has been properly received (col. 14 line 47 through col. 15 line 6).

Conclusion

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any response to this action should be mailed to:

Mail Stop_____ (Explanation, e.g., Amendment, After-final, etc.)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22313

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571)272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571)272-7882882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan Nguyen/
Examiner
Art Unit 2618

/Nay A. Maung/
Supervisory Patent Examiner, Art
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